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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,152	09/25/2006	Hideomi Koinuma	063111	6075
38834 7590 12/18/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER HO, ANTHONY	
			ART UNIT 2815	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/594,152	KOINUMA ET AL.	
	Examiner	Art Unit	
	Anthony Ho	2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/2006, 3/23/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 1-10 and 21-24 in the reply filed on September 19, 2007 is acknowledged.

Accordingly, claims 11-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 19, 2007.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on September 25, 2006 was filed after the mailing date of the instant application on September 25, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement (IDS) submitted on March 23, 2007 was filed after the mailing date of the instant application on September 25, 2006. The submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings filed on September 25, 2006 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

Claims 1-10 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "organic thin film" in line 1 and line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "organic thin film" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "organic thin film" in line 1 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "organic thin film" in line 1 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "organic thin film" in line 1 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "organic thin film" in line 1 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the buffer layer" in lines 2-3 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "organic thin film" in line 1 and line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "organic thin film" in line 1 and line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "organic thin film" in line 2 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "organic thin film" in line 2 of the claim.  
There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shi et al (US Patent 6,326,640).

Shi et al discloses a transistor with a buffer layer (23) and an organic thin film (24) sequentially deposited on a substrate (Figure 2; column 3).

The recitation “said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed

apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

Claims 1-3, 6-8 and 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hirai (US PUB 2003/0160235).

In re claims 1 and 6, Hirai discloses a transistor with a buffer layer (4) and an organic thin film (3) sequentially deposited on a substrate (Figures 5(a) – 5(c); paragraph 0095 – paragraph 0116).

The recitation “said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

In re claims 2 and 7, Hirai discloses a thin layer (S',D') between the substrate (1) and the buffer layer (Figures 5(a) – Figure 5(c); paragraph 0095 – paragraph 0116).

The recitation "characterized in that a layer easily oriented with said buffer layer" in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

In re claims 3, 8 and 21-24, Hirai discloses the substrate is an insulating substrate and the buffer layer and organic thin film comprises one of the listed materials (paragraph 0095 – paragraph 0116).

Claims 1-3, 6-8 and 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kelley et al (US Patent 6,433,359).

In re claims 1 and 6, Kelley et al discloses a transistor with a buffer layer (16) and an organic thin film (18) sequentially deposited on a substrate (Figure 1; column 3 – column 7).

The recitation "said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly" in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure



rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

In re claims 2 and 7, Kelley discloses a thin layer (14) between the substrate (26) and the buffer layer (Figure 1; column 3 – column 7).

The recitation “characterized in that a layer easily oriented with said buffer layer” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

In re claims 3, 8 and 21-24, Kelley et al discloses the substrate is an insulating substrate and the buffer layer and organic thin film comprises one of the listed materials (column 3 – column 7).

Claims 1, 3-6, 8-10 and 21-24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Afzali-Ardakani et al (US PUB 2004/0183070).

In re claims 1 and 6, Afzali-Ardakani et al discloses a transistor with a buffer layer (110) and an organic thin film (120) sequentially deposited on a substrate (Figure 4a; paragraph 0069 – paragraph 0071).

The recitation “said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

In re claims 3-5, 8-10 and 21-24, Afzali-Ardakani et al discloses the substrate is a sapphire substrate and the buffer layer and organic thin film comprises one of the listed materials (paragraph 0069 – paragraph 0071).

Furthermore, the claimed invention is a product-by-process claim and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 103***

Claims 3-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai (US PUB 2003/0160235) as applied to claims 1 and 6 above, and further in view of Afzali-Ardakani et al (US PUB 2004/0183070). Afzali-Ardakani et al discloses a buffer layer (110) of an organic semiconductor device comprises pentacene (paragraph 0070) and the substrate (100) is a sapphire substrate (paragraph 0069) (Figure 4a).

The advantage is to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices (paragraph 0023). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transistor as taught by Hirai with a buffer layer of an organic semiconductor device comprises pentacene and the substrate is a sapphire substrate as taught by Afzali-Ardakani et al in order to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices.

Furthermore, the claimed invention is a product-by-process claim and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 3-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley et al (US Patent 6,433,359) as applied to claims 1 and 6 above, and further in view of Afzali-Ardakani et al (US PUB 2004/0183070). Afzali-Ardakani et al discloses a buffer layer (110) of an organic semiconductor device comprises pentacene (paragraph 0070) and the substrate (100) is a sapphire substrate (paragraph 0069) (Figure 4a).

The advantage is to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices (paragraph 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transistor as taught by Kelley et al with a buffer layer of an organic semiconductor device comprises pentacene and the substrate is a sapphire substrate as taught by Afzali-Ardakani et al in order to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices.

Furthermore, the claimed invention is a product-by-process claim and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afzali-Ardakani et al (US PUB 2004/0183070) as applied to claims 1 and 6 above, and further in view of Redecker (US Patent 6,872,969).

Redecker discloses a layer (8) between a buffer layer (7) and substrate (1) in a semiconductor device (Figure 2).

The recitation "characterized in that a layer easily oriented with said buffer layer" in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

The advantage is to obtain a lightweight, highly flexible, easy-to-manufacture semiconductor device (column 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transistor as taught by Afzali-

Ardakani et al with a layer between a buffer layer and substrate in a semiconductor device as taught by Redecker in order to obtain a lightweight, highly flexible, easy-to-manufacture semiconductor device.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley et al (US Patent 6,433,359) in view of Afzali-Ardakani et al (US PUB 2004/0183070).

Hirai discloses a transistor with a buffer layer (4) and an organic thin film (3) sequentially deposited on a substrate (Figures 5(a) – 5(c); paragraph 0095 – paragraph 0116).

The recitation “said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

Afzali-Ardakani et al discloses a buffer layer (110) of an organic semiconductor device comprises pentacene (paragraph 0070) and the substrate (100) is a sapphire substrate (paragraph 0069) (Figure 4a).

The advantage is to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices (paragraph 0023). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transistor as taught by Hirai with a buffer layer of an organic semiconductor device comprises pentacene and the substrate is a sapphire substrate as taught by Afzali-Ardakani et al in order to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai (US PUB 2003/0160235) in view of Afzali-Ardakani et al (US PUB 2004/0183070).

Kelley et al discloses a transistor with a buffer layer (16) and an organic thin film (18) sequentially deposited on a substrate (Figure 1; column 3 – column 7).

The recitation “said buffer layer accelerates two dimensional growth of said organic thin film, and orients said organic thin film flatly” in the claim is functional language and is treated as nonlimiting since it has been held that in device claims, the device must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. See MPEP 2114.

Afzali-Ardakani et al discloses a buffer layer (110) of an organic semiconductor device comprises pentacene (paragraph 0070) and the substrate (100) is a sapphire substrate (paragraph 0069) (Figure 4a).

The advantage is to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices (paragraph 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transistor as taught by Hirai with a buffer layer of an organic semiconductor device comprises pentacene and the substrate is a sapphire substrate as taught by Afzali-Ardakani et al in order to avoid using high-temperature or costly, high-vacuum processes to obtain the organic semiconductor devices.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Epstein et al (US PUB 2003/0001154)
- b. Tsumura et al (US Patent 5,500,537)

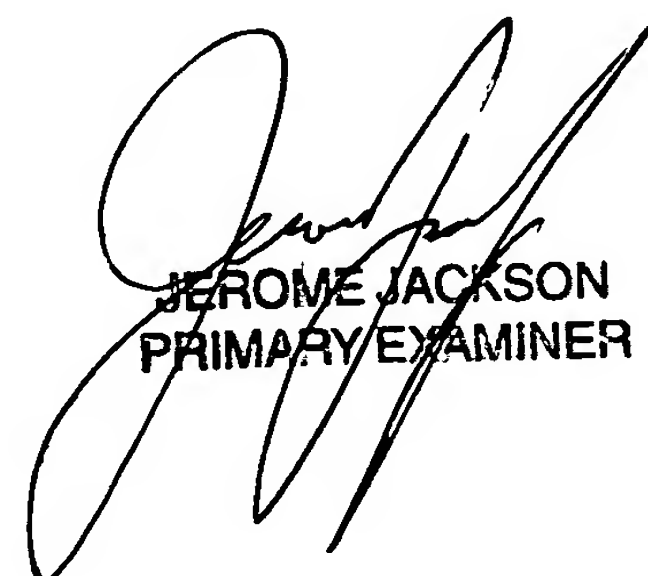
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ho whose telephone number is 571-270-1432. The examiner can normally be reached on M-Th: 8:30AM-7:00PM EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH  
December 4, 2007



JEROME JACKSON  
PRIMARY EXAMINER